

This election is made with traverse. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

The Manual of Patent Examining Procedure ("MPEP") § 803 (Original Eighth Edition, August 2001, Revision 3 August 2005), states that "[i]f a search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent and distinct inventions." Thus, the Patent Office encourages the search and examination of an entire application on the merits, where such search and examination can be made without serious burden. Further, searches that may require the examination of different classifications, separate commercial databases, automated patent system (text) searches are not a proper standard for restriction requirement.

In the present case, Applicant respectfully asserts that the search of restriction Groups I-IV does not impose a serious burden upon the Examiner, as a search concerning the patentability of the invention of one group will clearly uncover art of interest to the other groups. Applicant would like to direct the Examiner's attention to the parent application of the present application. The present application is a divisional application of Ser. No. 09/092,486, filed on June 5, 1998, now issued as U.S. Patent No. 6,670,332 ("the '332 patent"). During a telephone conversation on March 8, 2006, Applicant's undersigned representative, Matthew J. Dowd, informed the Examiner of the existence of the '332 patent.

Applicant notes that the scope of the Markush group in the pending claims of the present application is identical to the scope of the Markush group in the claims of the '332 patent. During the examination of the '332 patent, the Examiner was able without serious burden to search the entire scope of the claimed genus of compounds. The Examiner determined that the claimed compounds of the '332 patent were patentable.

In the present case, Applicant is claiming a method of using the patentable compounds. The method claims were restricted from the application of the '332 patent. Substantially the same search which the Examiner of the '332 patent performed can be done without serious burden in the present case.

Furthermore, as shown above, the allegedly distinct groups, as divided by the Examiner, cover overlapping subject matter. Claims 64 and 71 both cover the elected species of DMRIE carboxylate propyl amide. Claim 64 was placed in Restriction Group I, and claim 71 was placed in Restriction Group II. If the Examiner were to restrict the claimed invention, two separate patents could issue that cover the elected species. Because those two patents would not be subject to an obviousness-type double patenting rejection, *see* 35 U.S.C. § 121, the present restriction requirement could result in a timewise extension of the patent right covering subject matter examined in the present application. *See* MPEP § 803.01 ("[I]T REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION." (emphasis in original)).

Therefore, Applicant respectfully submits that, in the present case, restriction to one of four groups of allegedly distinct inventions, as required by the Examiner, is improper. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Matthew J. Dowd
Agent for Applicant
Registration No. 47,534

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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